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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/819,687

03/29/2001

Eiji Natori

109121

3151

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02/25/2005

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EXAMINER

GUERRERO, MARIA F

ART UNIT

PAPER NUMBER

2822

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

09/819,687

Applicant(s)

NATORI, EIJI

Examiner

Maria Guerrero

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-25, 27-40, 52-55, 57, 59 and 60 is/are pending in the application.
- 4a) Of the above claim(s) 11-22, 52-55, 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-25, 27-40, 57 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the Amendment filed November 26, 2004 and the Request for continued examination filed December 27, 2004.

Status of Claims

2. Claims 1-10, 26, 41-51, 56, and 58 are canceled. Claims 11-25, 27-40 and 52-55, 57, 59, and 60 are pending.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 27, 2004 has been entered.

Election/Restrictions

4. This application contains claims 11-22 and 52-55 drawn to an invention nonelected with traverse in Paper No. 10 and claim 60 being withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. A complete reply to the rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Information Disclosure Statement

5. The information disclosure statement filed December 15, 2004 has been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 23-25, 27-40, 57, and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23, 25, 57, and 59 recite "forming a plurality of film-forming regions which are aligned in a predetermine pattern"; the claims are vague and indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 23-25, 27-40, 57 and 59 are rejected under 35 U.S.C. 102(e) as being anticipated by Paz de Araujo et al. (U.S. 6,110,531).

8. Paz de Araujo et al. teaches (as interpreted by examiner in regards to the 112 2nd paragraph rejection) feeding an electromagnetic wave and active species of a substance, which is at least part of raw material to a region on a substrate to form a ceramic film (col. 6, lines 50-55, col. 9, lines 8-40). Paz de Araujo et al. teaches a method of mixing a ferroelectric precursor with an active species and applying the film by misted CVD process (Fig. 3, col. 5, lines 21-30, 45-56, col. 13, lines 50-65, col. 14, lines 1-10).

9. Paz de Araujo et al. discloses the active species being a radical or ion of the raw material species (Fig. 3, col. 5, lines 21-30, col. 8, lines 8-30). Paz de Araujo et al. shows the active species being oxygen or nitrogen or inert argon gas, the active species being fed to the substrate (Fig. 3). Paz de Araujo et al. teaches forming a first ceramic film in an amorphous state (having low crystallinity) (col. 2, lines 19-25, col. 14, lines 50-65).

10. Paz de Araujo et al. shows the thickness of the film being in the range of 50 to 5000 angstroms (col. 4, lines 24-27). Paz de Araujo et al., in a broad interpretation, shows the steps as claimed because the steps of forming the film-forming region, the non-film forming region, and the self-alignably ceramic film are taught by Paz de Araujo et al. reference (see Fig. 10-11, col. 13, lines 19-45, col. 14, lines 10-65).

Paz de Araujo et al. teaches a means for forming ceramic film including s means for feeding an electromagnetic wave and active species to the region smaller than the entire surface of the substrate (Fig. 2, 4, col. 6, lines 1-55).

In addition, the elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Response to Arguments

11. Applicant's arguments filed December 27, 2004 have been fully considered but they are not persuasive. Claims 23-25, 27-40, 57 and 59 stand rejected.

Applicant argued that Paz de Araujo et al. does not teach a region for forming a ceramic film being part of a substrate. However, Paz de Araujo et al. discloses a region for forming a ceramic film being part of a substrate (Fig. 10, col. 13, lines 19-50, col. 14, lines 26, col. 16, lines 5-20).

Applicant argued that Paz de Araujo et al. does not teach forming a film-forming region having affinity to ceramics to be formed and a non-film forming region having no affinity to ceramics to be formed, to form self-alignably a ceramic film in the film-forming region. However, in a broad interpretation of the claims, a person of ordinary skill in the art would recognize that Paz de Araujo et al. shows the steps as claimed because the steps of forming the film-forming region, the non-film forming region, and the self-alignably ceramic film are taught by Paz de Araujo et al. reference (see Fig. 10-11, col. 13, lines 19-45, col. 14, lines 10-65). In addition, the elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Furthermore, during patent examination, the pending claims must be "given
*>their< broadest reasonable interpretation consistent with the specification." > In re
Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). While the claims
of issued patents are interpreted in light of the specification, prosecution history, prior
art and other claims, this is not the mode of claim interpretation to be applied during
examination. During examination, the claims must be interpreted as broadly as their
terms reasonably allow. > In re American Academy of Science Tech Center, F.3d , 2004
WL 1067528 (Fed. Cir. May 13, 2004)(The USPTO uses a different standard for
construing claims than that used by district courts; during examination the USPTO must
give claims their broadest reasonable interpretation.) < This means that the words of the
claim must be given their plain meaning unless applicant has provided a clear definition
in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir.
1989) >; Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d
1857 (Fed. Cir. 2004).

In response to applicant's argument that the references fail to show certain
features of applicant's invention, it is noted that the features upon which applicant relies
(i.e., without patterning) are not recited in the rejected claim(s). Although the claims are
interpreted in light of the specification, limitations from the specification are not read into
the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the remarks about the term substrate, Paz de Araujo et al. uses the
term substrate in general and specific sense (col. 16, lines 5-20). Paz de Araujo et al.

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also suggest that the invention is not limited to the presented embodiments and examples (col. 13, lines 20-50, col. 14, lines 10-25, col. 16, lines 5-20).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hintermaier et al. (US 6,120,846) and Mihara et al. (US 5,466,629) (incorporated by reference on Paz de Araujo et al. (U.S. 6,110,531)) are presented as evidence to support the conclusion that a person of ordinary skill in the art would recognize that the steps of forming the film-forming region, the non-film forming region, and the self-alignably ceramic film are taught by Paz de Araujo et al. reference.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria Guerrero whose telephone number is 571-272-1837.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on 571-272-1852. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 18, 2005


MARIA F. GUERRERO
PRIMARY EXAMINER